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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/670,118	09/26/2000	MICHAEL S. DARSILLO	99078X206650	5497

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EXAMINER

BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/670,118

Applicant(s)

DARSILLO ET AL.

Examiner

Kevin M Bernatz

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.


NOTE: \_\_\_\_\_


3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-3, 5, 7, 29, 30, 33, 44-48 and 58-67.Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700

  
3/25/04

Continuation of 5. does NOT place the application in condition for allowance because: applicants' arguments and the Declaration of Mr. Morris have been considered, but have not been found persuasive. Specifically, applicants argue that Nagamine et al. does not teach or render obvious the claimed invention because the particles in Example 3 are not fumed alumina particles and that Nagamine et al. teach away from substituting fumed alumina for the particles in Example 3 based on the use of fumed alumina in Example 4. The Examiner respectfully disagrees.

Applicant(s) are reminded that the rejection is based on the entire reference(s) and not just a piece meal analysis of the cited reference(s). In the instant case, Nagamine et al. is primarily directed to the use of a dual layered ink-jet recording media, wherein the upper layer possesses particles with a larger surface area than the lower layer (*col 4, lines 40 – 44*). While preferably the upper layer possesses particles with a surface area of  $90 \text{ m}^2/\text{g}$  or greater, Example 3 combined with the teachings in col. 4, lines 5 – 10 provide clear evidence that Nagamine et al. encompass embodiments where the surface area is less than  $90 \text{ m}^2/\text{g}$  in the upper layer, provided that they are still greater than the surface area of the particles in the lower layer. As such, while the Examiner finds Mr. Morris's declaration convincing that the particles recited in Example 3 are not fumed alumina particles, the combined teaching of Nagamine et al. clearly provides for the use of fumed alumina meeting applicants' claimed surface area limitations.

Applicants further argue that Mukoyoshi et al. and Okumura et al. are not analogous art since both references are directed to non-hydrated or fumed alumina and one of ordinary skill in the art would not have turned to the above references for particle size or surface area limitations since the chemistry and structure of the particles are extremely different. The Examiner respectfully disagrees.

While the Examiner acknowledges Mr. Morris's position in the declaration, the Examiner does not find the argument persuasive based on the preponderance of prior art evidence which suggests the interchangeability of alumina and silica particles for the use of absorbing ink (*e.g. Mochizuki et al.: col. 2, lines 57 – 61; col. 3, lines 5 – 30; an col. 4, lines 26 – 37; and Okumura et al.: col. 3, lines 5 – 18 and col. 3, line 60 bridging col. 4, line 18*). The Examiner notes that the particles all serve the same function in an ink jet recording medium, specifically the absorption of ink. The size and surface area of the particles are factors affecting the rate and capacity of ink absorption and the exact choice of particles is deemed within the knowledge of one of ordinary skill in the art, given the knowledge that the size and surface area are essential factors to tailor the ink absorption properties (*see Okumura et al., col. 3, line 60 bridging col. 4, line 18*).

Finally, applicants argue that the Examiner's position that fumed alumina does not possess a structure "indistinguishable from other forms of alumina" (page 9 of response) is incorrect. The Examiner respectfully disagrees.

The Examiner notes that the Office Action stated that the various forms of alumina were *equivalents*, not that their structures were "indistinguishable" from each other. As exemplified by the cited prior art, one of ordinary skill in the art at the time of applicants' invention would have recognized that alumina can be made by many different methods and that regardless of the type of alumina produced, such alumina can be used for ink jet recording media. Presently there is no evidence of record indicating any *unexpected* improvement when fumed alumina is used versus other types of alumina in ink jet recording media.